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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215449
Party	Defendant Nuclear Wine Company LLC
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	08/20/2014
Attachments	Lumen Motion to Amend Reply Brief.pdf(16923 bytes)

LUMEN mark for water from the pre-existing LUMENE registration, also for water. This, however, is not the test for determining whether a registration should be partially cancelled under §18. Rather, the test is (1) whether the proposed restriction will avoid a likelihood of confusion and (2) whether, at the time that the restriction is sought, Opposer is, in fact, not using its mark on the goods sought to be excluded by the proposed restriction. *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266 (TTAB 1994). When this test is satisfied, partial cancellation is appropriate. *Id.*

Because Opposer has admitted that its sales of water are limited “exclusively to couture establishments,” and because Applicant sells neither water nor to couture establishments, Applicant’s proposed restriction to the goods identified in the ‘059 registration will avoid a likelihood of confusion as the goods, their channels of trade, and their marketing are different for Opposer and Applicant. As a result, Applicant’s Amended Answer is not legally insufficient, and Applicant is entitled to the requested restriction under §18.

Finally, and as previously noted, Rule 15(a) of the Federal Rules of Civil Procedure provides that leave to amend pleadings shall be freely given when justice so requires. This requirement is echoed in TBMP §507.02 (“leave must be freely given when justice so requires”). *See also Cool-Ray, Inc. v. Eye Care, Inc.*, 183 U.S.P.Q. (BNA) 618, 1974 WL 20036 at *3 (T.T.A.B. 1974) (the Patent and Trademark Office liberally grants motions to amend). Because Opposer will not be prejudiced by Applicant’s requested amendment due to the early stage of these proceedings and the fact that all evidence relating to Applicant’s Counterclaim is already in Opposer’s possession, Applicant’s Motion to Amend should be granted.¹ TBMP §507.02 (“the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so

¹ Tellingly, in its Opposition brief, Opposer was unable to identify any prejudice that it would suffer from Applicant’s proposed Amended Answer.

requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.”) and 507.02(a). *See also Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (amendment permitted because proceeding was still in the discovery stage and no undue prejudice was shown).

CONCLUSION

WHEREFORE, given that Opposer will not be prejudiced by Applicant's Amended Answer and given that Applicant's Amended Answer is legally sufficient and will avoid any likelihood of confusion, Applicant respectfully requests that the Board grant its Motion to file its Amended Answer to Notice of Opposition and Counterclaim.

Dated: August 20, 2014

Respectfully submitted,

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ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Motion for Leave to File Amended Answer to Add Counterclaim Reply Brief has been served on Opposer's attorney, Dyan M. House, Carter Scholer Arnett Hamada & Mockler, PLLC, 8150 N. Central Expy., 5th Floor, Dallas, TX 75206, via Federal Express on this 20th day of August, 2014.

/Diana Medina/

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